

REMARKS

Status of the Claims

With entry of the above amendment, claims 1, 2, 4, 6-11, 13-17, 19, 21-26, 28-55, 59, 66, and 68-79 are pending. The Office has made two anticipation rejections of claims 1, 2, 14-17, 41, 48, 56-59, 62, 64, and 66 under 35 U.S.C. § 102(b), and one obviousness rejection of claims 29-33 and 42-46 under 35 U.S.C. § 103(a). Office Action, pages 1-3 Applicant acknowledges and appreciates the indication of allowability of claims 68-73. *Id.*, page 3. Also, the Office indicates that claims 3-13, 18-28, 34-40, 47, 49-55, 60, 61, 63, 65, and 67 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. *Id.* No claims are currently withdrawn from consideration as being drawn to non-elected subject matter. *Id.*, page 1.

Applicant cancels claims 3, 5, 12, 18, 20, 27, 56-58, 60-65, and 67 without prejudice or disclaimer to the subject matter claimed therein. Applicant reserves the right to pursue any canceled subject matter in a continuation application.

Applicant amends the remaining claims so that they encompass the subject matter indicated as allowable by the Office:

Claim 1 now recites the limitations of dependent claim 5.

Claim 14 now recites the limitations of dependent claim 20.

Claim 59 now recites the limitations of dependent claims 60, 61, and 63.

Claim 66 now recites the limitations of dependent claim 67.

New claims 74-79 also encompass subject matter indicated as allowable by the Office:

Claim 74 recites the combined limitations of claims 1 and 3.

Claim 75 recites the combined limitations of claims 1 and 4.

Claim 76 recites the combined limitations of claims 1 and 12.

Claim 77 recites the combined limitations of claims 14 and 18.

Claim 78 recites the combined limitations of claims 14 and 19.

Claim 79 recites the combined limitations of claims 14 and 27.

Claims 6 and 21 have been amended to recite the appropriate antecedent basis and claim dependency. Support for all amendments are found in the specification as filed. The provisos in new claims 75, 76, 78, and 79 recite "...with the proviso that at least one of said R' comprises at least one unsaturated hydrocarbon comprising no heteroatoms." Support for the provisos is found in the specification as filed, for example, at page 7, lines 4-13, the "unsaturated hydrocarbon" optionally comprises heteroatoms. No new matter has been added.

I. The Claims Are Not Anticipated Under 35 U.S.C. § 102

Fan and Raposo

Claims 1, 2, 14-17, 41, 48, 56-59, 62, 64, and 66 are rejected under 35 U.S.C. § 102(b) as being anticipated by Fan *et al.*, J. Chem. Soc., Chem. Comm, 12:1251-1252 (1995) ("*Fan*") and Raposo *et al.*, Tetrahedron Letters 36:3255-3258 (1995) ("*Raposo*"). (Office Action, page 2.) Applicant traverses the rejections in view of the current

amendment. Cancellation of claims 56-58, 62, and 64 renders the rejection of these claims moot.

Regarding *Fan*, the Office states that *Fan* discloses "the instant compound where Y = -CONHR' and R' = methyl pyridyl. The aromatic pyridyl ring is an unsaturated hydrocarbon. See abstract." (*Id.*) Regarding *Raposo*, the Office states that *Raposo* discloses "the instant compound where Y = -CONHR' and R' = oxygenated biaryl ring. The oxygenated biaryl ring is an unsaturated hydrocarbon. See abstract." (*Id.*)

In order to anticipate a claim, the cited reference must disclose all of the recited limitations of the claim. Applicant submits that the claims as amended are distinguished from the cited references. Claims 1 and 14, and claims dependent thereon, now recite the limitation of claim 5 and 20, respectively, "wherein at least one of said R' groups is chosen from linear and branched, saturated and unsaturated hydrocarbons...", wherein all of the R' groups in *Fan* and *Raposo* are cyclic hydrocarbons. Therefore, the cited references do not disclose all of the recited limitations, either explicitly or inherently, of rejected claims 1, 2, 14-17, 41, and 48. Further, the Office has indicated that the subject matter of claims 5 and 20 would be allowable if rewritten in independent form, and Applicant has done so in the foregoing amendment. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections.

Claim 59 now recites the limitations of claims 60, 61, and 63, and claim 66 recites the limitations of dependent claim 67. The Office has indicated that the subject matter of claims 60, 61, 63, and 67 would be allowable if rewritten in independent form, and Applicant has done so in the foregoing amendment. Accordingly, Applicant respectfully requests reconsideration and withdrawal of these rejections.



In addition, new claims 74-79 also encompass subject matter indicated as allowable by the Office. Claim 74 recites the combined limitations of claims 1 and 3. Claim 75 recites the combined limitations of claims 1 and 4. Claim 76 recites the combined limitations of claims 1 and 12. Claim 77 recites the combined limitations of claims 14 and 18. Claim 78 recites the combined limitations of claims 14 and 19. Claim 79 recites the combined limitations of claims 14 and 27.

Applicant submits that the pending claims are in condition for allowance. Accordingly, Applicant respectfully requests entry of the amendment and reconsideration and withdrawal of the rejections.

II. The Claims are not Obvious Under 35 U.S.C. § 103(a)

Claims 29-33 and 42-46 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Fan* or *Raposo* as applied to claims 1, 2, 14-17, 41, 48, 56-59, 62, 64, and 66 as described above (Office Action, page 3.) Applicant traverses the rejection as the rejection is moot in view of the current amendment, as discussed above.

The rejection is moot because the Office has indicated that the subject matter of claims 20 is allowable, and claims 14, upon which the rejected claims depend, has been amended to recite the limitations of claim 20. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections.

CONCLUSION

Applicant therefore respectfully requests reconsideration of the application, and the timely allowance of the pending claims. Please grant any extensions of time required to enter this amendment and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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